

## REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Rejection Under 35 USC §101

This rejection has been addressed by amending claim 1 to recite the advertising server that implements the claimed method, and the network over which advertisements and access to addresses, services, or content are exchanged, as suggested in item 1 on page 2 of the Official Action.

2. Rejection of Claims 1-3, 8-11, 21, 22, 26-29, 35, and 36 Under 35 USC §102(e) in view of U.S. Patent No. 6,379,251 (Auxier)

Each of the independent claims has been amended to emphasize that the banner ads of the invention block or prevent access to a website (address, content, or service) which the user has indicated a desire to access. In other words, the invention only presents a banner ad when the user attempts to access a particular “desired” website, and then blocks access to the site that the user is attempting to access. This is in contrast to click through ads which enable—or block (see the Auxier patent)—access to a site *other than* the “desired” site that the user was originally attempting to access when the ad was presented.

The rejection under 35 USC §102(e) is therefore respectfully traversed on the grounds that the Auxier patent fails to disclose or suggest banner ads which **blocks** access to an address, service, or content, *i.e.*, to a *user-requested* web page, unless an appropriate response to the ad is made by the user. It is noted that blocking access in the absence of an appropriate response is the same as permitting access “only if” the appropriate response is made, so the scope of the claims has not changed.

While it is true that the banner ads taught by the Auxier patent are interactive, they do not permit access to a “desired” site requested by the user only if the user responds appropriately, as

claimed. Instead, interaction with the banner ads of Auxier appears to be optional, and response to the ads re-directs the user to the sponsor of the ad and not to the originally requested address, service, or content. If the user does not interact or respond to the ad, the user can still access the requested address, service, or content.

According to the Examiner, col. 8, lines 60-65 and Fig. 4 of the Auxier patent disclose “blocking” access to a requested site. However, the site to which access is blocked is a site to which the banner ad provides a link, *i.e.*, a click through site, which is not the same as the site originally requested by the user, and which was blocked by the appearance of the banner ad. Auxier does not block access to the site requested at the time the banner ad was originally presented, but merely blocks access to a reward site *after* interaction has occurred. This passage in Auxier does not disclose the claimed blocking of access to a desired site, *i.e.*, the site originally requested by the user, but rather merely discloses that click-through to the third party site can be prevented if the interactive game play results in the user “losing” the game. The user is still free to access the originally intended site that invoked display of the banner ad in the first place.

The nature of the “click-through” ads of Auxier, which direct (or block) access to a third party site different from the originally requested site, can be understood from the description in col. 3, lines 56-61 of the Auxier patent:

*As noted, the banner ad is both an advertisement and a link to the merchant's web site. If the user viewing the web page that is displayed on client computer 130 find the banner ad appealing, the user can click on the banner ad and be transferred or linked to the merchant's website.*

This passage goes on to explain that the problem with this type of banner ad is that viewers respond only 2% of the time the ad is viewed. The solution is to make interaction with the ads more attractive, as explained in col. 4, lines 1-6:

*The present invention improves upon the static banner ad delivery system by increasing the user's ability to interact with the banner ad that is displayed on the web page. The user interactivity described below greatly enhances the click-through rates as compared to the delivery of conventional static banner ad graphic images.*

In other words, the objective of Auxier's method is to enhance the click-through rate by making click through more fun. The user plays a game on the banner ad, which has the effect of clicking the user through to the *sponsor's* website. This is not how the claimed invention operates. Instead, of providing an alternate click through path by enticing the viewer away from an intended website, the claimed invention blocks the path to the intended website and requesting interaction, *but once the interaction is complete*, the path is unblocked and the viewer proceeds to the intended website and not to a third party sponsor's website.

The Examiner will note that claim 1, for example, recites that the banner ad is presented "*when a user indicates a desire to access an address, service, or content,*" and that it is the desired address, service, or content, rather than a third party website, that the user is prevented from accessing. The desired website/third party website distinction can be understood from the simple example of a website intended for student education, which the student desires to access, and a third party website directed to a pizza delivery service:

In the conventional click-through method, when the user indicates a desire to access the education website, the pizza ad is presented, the third party provider attempting to lure the student away from the educational site to the pizza site, at least long enough for the student to order a pizza. However, the student is free to ignore the ad and proceed to access the educational site. In the Auxier method, the ad includes a game which, if played, might entice the user away from education site to the pizza site. The pizza site might even offer a reward of a free pizza to those who win the game, and prevent access to the reward page to those who lose. **However, the method of Auxier never prevents or blocks access to the originally intended and desired educational site.** In contrast, the claimed invention actually prevents access to the educational site until the user has, for example, viewed pictures of pizzas and clicked on his or her favorite.

In the above example, when the user types the educational URL into his or her browser, by pre-arrangement with the educational website or a local ad server, the pizza ad will appear in

the browser and request an appropriate response. **If the user does not respond to the pizza add, the user will not be able to access the educational website. If the user does respond, he or she is not taken to a pizza website, but rather is permitted to access the educational website.**

The claimed invention can of course be used for banner ads other than commercial ads, including public service messages and subscription or upgrade solicitations. However, in each case, the “ads” are used to block access to a site originally selected by the user, *before* appearance of the ad, and not to block or permit access to a site linked to the ad itself, as in the Auxier method. Thus, the claimed method and system does not operate in the same manner as the method and system disclosed by Auxier.

Because the Auxier patent does not disclose all elements recited in claims 1-3, 8-11, 21, 22, 26-29, 35, and 36, withdrawal of the rejection under 35 USC §102(e) is respectfully requested.

3. Rejection of Claims 7 and 25 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier) and 6,286,045 (Griffiths)

This rejection is respectfully traversed on the grounds that the Griffiths patent, like the Auxier patent, fails to disclose or suggest an interactive banner ad that blocks access to a requested website unless an appropriate response is made by the user, as opposed to merely seeking to entice a viewer to click through to a third party provider.

Instead, the Griffiths patent discloses a system for managing “banner ads,” defined as “*any information displayed in conjunction with a web page wherein the information is not part of the same file as the web page,*” by using a proxy server that enables an accurate count of the number of the times the ad has been presented, no matter what the source, and even if the ad is locally cached. Nowhere does the Griffiths patent disclose or suggest that the banner ads are presented in such a way that failure to respond to or interact with the ad will block access to a

service, content, or address requested by the user. Accordingly, withdrawal of the rejection of claims 7 and 25 under 35 USC §103(a) is requested.

4. Rejection of Claims 4-6, 12-15, 19, 20, 23, 24, 30, 31, 32, 37-39, and 42-49 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier) and 6,011,537 (Slotznick)

This rejection is respectfully traversed on the grounds that the Slotznick patent, like the Auxier patent, fails to disclose or suggest an interactive banner ad that blocks access to a requested website unless an appropriate response is made by the user, as opposed to merely seeking to entice a viewer to click through to a third party provider.

The Slotznick patent merely discloses the well-known technique of presenting a banner ad when a user request access to content over a network. If the user fails to interact with the banner ad, the user is clearly not prevented from accessing the requested content. Neither the Auxier patent nor the Slotznick patent discloses or suggest permitting access to the requested content only if the user interacts with the banner ad, as claimed. Accordingly, withdrawal of the rejection of claims 4-6, 12-15, 19, 20, 23, 24, 30, 31, 32, 37-39, and 42-49 under 35 USC §103(a) is requested.

5. Rejection of Claims 16-18, 33, 34, 40, and 41 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 6,011,537 (Slotznick) and 6,011,537 (Eggleston)

This rejection is respectfully traversed on the grounds that the Eggleston patent, like the Slotznick and Auxier patents, fails to disclose or suggest an interactive banner ad that permits access to a requested website “only if” the user interacts with the banner ad, as opposed to merely seeking to entice a viewer to click through to a third party provider.

Instead, the Eggleston patent merely discloses an incentive system that provides rewards in the form of credits for viewing advertisements. The user is not required to interact with any particular ad in order to access a requested content. Furthermore, according to one aspect of the method of the claimed invention, the user is rewarded for accumulating credits by **not** having to view the banner ad in order to access the requested content, and according to another aspect of

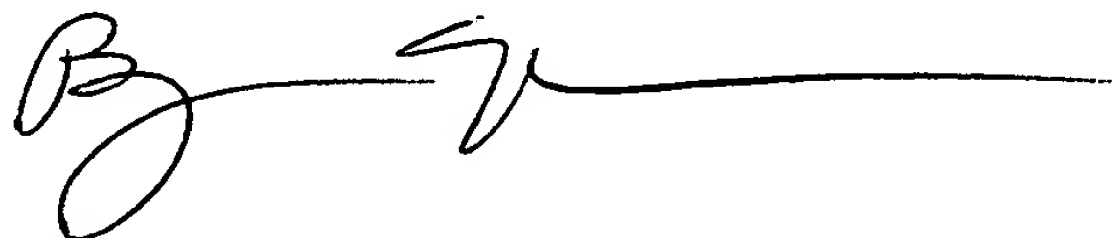
Serial Number 09/742,438

the claimed invention, the credits are applied to a subscription of the content requested. The incentive of **not** having to view banner ads or of reducing subscription costs for content accessed upon interaction with a banner ad is not even remotely suggested by the Eggleston, Slotznick, and Auxier patents, whether considered individually or in any reasonable combination.. Accordingly, withdrawal of the rejection of claims 16-18, 33, 34, 40, and 41 under 35 USC §103(a) is requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to be 'B. Urcia', with a long horizontal line extending to the right.

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